

REMARKS/ARGUMENTS

O.A. No. 4. The rejection of Claims 21 – 24 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is respectfully traversed, as follows.

Given the claim amendments and the remarks below, Applicant believes that Claims 21 – 24 have overcome the 35 U.S.C. 112, second paragraph rejections and are now in condition for allowance.

O.A. No. 5. Examiner argues that Claims 21-23, line 4 of each claim, recite “said solid object” without antecedent basis.

Applicant recites the antecedent basis in the preamble of each claim, as follows:

“Claim 21 (previously presented) A self-illuminating fabricated solid object assembly comprising: . . .”

Claim 22 (previously presented) A self-illuminating fabricated solid object assembly comprising: . . .”

Claim 23 (previously presented) A self-illuminating fabricated solid object assembly comprising: . . .”

Both case law and the MPEP support Applicant in reciting essential structure in the preamble and, furthermore, there can be no confusion as to which “solid object” is the antecedent as there is no other “solid object” that could be a source of confusion.

“In general, a preamble limits the invention if it recites essential structure or steps, or if it is “necessary to give life, meaning, and vitality” to the claim.” Pitney Bowes, 182 F.3d at 1305.

MPEP 2111.02 Effect of Preamble -- [A] claim preamble has the import that the claim as a whole suggests for it.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir.1999). See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329,

1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003). *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

The MPEP continues its support with such arguments as follow, "Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). (The claim at issue was directed to a driver for setting a joint of a threaded collar*>;< however>,< the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.)."

However, if Examiner does not find Applicant's argument persuasive, Applicant will amend the claims to specifically recite an antecedent within the body of the claim. If the Examiner should so conclude, if he desires he may communicate this to Applicant by telephone at 716 652-2380.

O. A. No. 6. Examiner argues that Claims 21-23 are indefinite. Applicant has amended each claim by adding “said” preceding “receptacle” as it occurs in paragraph (g) of each of the claims.

O. A. No. 7. Examiner argues that Claims 21-23 are indefinite because of the common recitation of the phrase “wherein said light source additionally comprises at least one fiber optic cable, said cable adapted for the transmission of light from said at least one exchangeable light source” in paragraph (g).

Although Applicant believes that paragraph (g) as recited clearly described the claimed structure, in response to Examiner’s holding of indefiniteness, Applicant has amended this phrase common to Claims 21-23 to recite:

“g) said at least one receptacle receiving an exchangeable light source **comprising a light emitting diode** providing for transmission of light from said exchangeable light source to said first end of said optical fiber, wherein said light source additionally comprises at least one fiber optic cable, said cable adapted for the transmission of light from said at least one exchangeable light source,”

where the bolded and underline text recites the phrase requested by the Examiner.

O. A. No. 8. Examiner argues that Claims 21-23 are indefinite because of the common recitation of the phrase “at least one receptacle receiving an exchangeable light source . . .” Examiner bases his conclusion in part on the wording of the claim and in part on pg. 13, paragraph 23, lines 10-12 of the specification that to Examiner indicates that “socket 48 is adapted for receiving fiber optical cable 70 and the light source means is remote from the solid object.”

This common recitation has been amended as discussed above, which may make the point moot. But, in any case, Examiner has taken the words of the specification out of context and away from their clear meaning.

[0023] A light source means may comprise a variety of light sources in a variety of operative configurations. A light source means may comprise a removable, replaceable plug-in LED (light emitting diode), as one example. Such an LED light source may be provided with the fabricated solid object or may be provided separately. FIG. 1d illustrates receptacle 22 having socket 48 where socket 48 may be adapted for directly or indirectly receiving a light source. For instance, socket 48 may be adapted for directly receiving a replaceable light

source, which in this example is illustrated as an LED light unit **40** with light emitting means **42** positioned for reversible insertion into socket **48**. Light emitting means **42** may be connected to a power source via socket **48**. **Alternatively, as illustrated in FIG. 1e, socket 48 may be adapted for receiving a fiber optic cable 70 that transmits light from a light source means,** such as light emitting means **42** that is remote from the solid object. Light emitting means **42**, may be functionally connect to power source **46** by means of socket or receptacle **72**. In this example, a fiber optic cable could provide a means to transmit light from one light source emitting means to a plurality of solid objects.

[0024] As is well-known in the art, each of the sockets or receptacles and the parts of the light sources means that are inserted into the sockets may be fitted with a lock mechanism. There are many lock mechanisms, such as when the thing that is inserted has two small pimple-like features, sometimes referred to as keys that fit into "key ways" that are incised into the sides of the receptacles to receive the keys. The key ways are usually curved where the curve accepts the keys as the keys are rotated as the thing that is inserted into the receptacle is rotated. The curvature of the key ways also provides a lock into which the keys are firmly positioned. The locking mechanism may also comprise a spring mechanism, a push button mechanism, or other locking means.

O.A. No. 9. Examiner states that in Claim 23, line 17 the limitation "at least one visually exposed surface" is indefinite as being the same as or different from the "at least one visually exposed surface" recited in preceding line 2.

The word "said" has been appropriately added and the recitation now reads "said at least one visually exposed surface."

O. A. Nos. 10 and 11. Examiner states that in Claim 24, lines 2-3 the limitation "said light source means" lacks antecedent basis and is indefinite in its relationship to the preceding "exchangeable light source."

Applicant has amended Claim 24 as Allowable Subject Matter and has included in the amendment the following to negate the requirement for antecedent basis and to address the indefiniteness question posed by Examiner in No. 11.

"g) said at least one receptacle receiving an exchangeable light source comprising a light emitting diode providing for transmission of light from said exchangeable light source to said first end of said optical fiber, wherein said light source additionally comprises at least one fiber optic cable, said cable adapted for the transmission of light from said at least one exchangeable light source,

wherein said at least one receptacle comprises locking means for securely holding said light source ~~means~~ in place."

Combining the changes in amended Claim 24 and the discussion provided above in the reply to **O. A. No. 8.**, Applicant believes Claim 24 is now in condition for allowance.

Remarks and Arguments:

In view of the following remarks, reconsideration of the outstanding Office Action is respectfully requested.

O. A. No. 13 and 14. The rejection of **Claims 21 and 22** under 35 U.S.C. 102(b) as being anticipated by MORI (U.S. Patent No. 4,510,555) is respectfully traversed and Applicant respectfully submits that considering amended Claims 21 and 22 Examiner has not established a *prima facie* case of anticipation.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP 2131

In regard to amended **Claims 21 and 22** , Claims 21 and 22 currently recite:

Claim 21 (amended) A self-illuminating fabricated solid object assembly comprising:

- a) at least one visually exposed surface;
- b) at least one aperture, said aperture opening on an accessible surface;
- c) at least one optical fiber positioned within said solid object;
- d) a first end of said optical fiber visually terminating at said visually exposed surface of said solid object;
- e) a second end of said optical fiber operatively related to said aperture to receive light,
- f) at least one receptacle operatively relating to said at least one aperture, said receptacle receiving said second end of said optical fiber providing for said second

end of said optical fiber to receive light,

g) said at least one receptacle receiving an exchangeable light source comprising a light emitting diode providing for transmission of light from said exchangeable light source to said first end of said optical fiber, wherein said light source additionally comprises at least one fiber optic cable, said cable adapted for the transmission of light from said at least one exchangeable light source.

Claim 22 (amended) A self-illuminating fabricated solid object assembly comprising:

a) at least one visually exposed surface;

b) at least one aperture, said aperture opening on an accessible surface;

c) at least one optical fiber positioned within said solid object;

d) a first end of said optical fiber visually terminating at said visually exposed surface of said solid object;

e) a second end of said optical fiber operatively related to said aperture to receive light,

f) at least one receptacle operatively relating to said at least one aperture, said receptacle receiving said second end of said optical fiber providing for said second end of said optical fiber to receive light,

g) said at least one receptacle receiving an exchangeable light source comprising a light emitting diode providing for transmission of light from said exchangeable light source to said first end of said optical fiber, wherein said light source additionally comprises at least one fiber optic cable, said cable adapted for the transmission of light from said at least one exchangeable light source,

wherein said at least one fiber optic cable is received by a plurality of solid objects.

Mori does not teach light emitting diodes as claimed by Applicant, therefore as each and every element as set forth in the claim is not found, either expressly or inherently described, in Mori and as the identical invention is not shown in as complete detail as is contained in Applicant's claim, Mori does not anticipate Applicant's invention.

In fact Mori, teaches his cable as one that carries light, such as sunlight, that must be condensed by a lens into an optical cable (see Col. 1, lines 9 – 13, Col. 2, lines

12 – 14, and Col. 2, line 40.). Condensing sunlight into a cable is taught as a means to construct ornamental lighting devices free from the generation of heat (Col. 1, lines 12 – 15).

Moreover, Mori's optical fiber's must be parallel to each other, which is not a requirement in Applicant's invention, and they must be spaced apart, which is not a requirement in Applicant's invention.

It follows then that Mori does not either expressly or inherently describe Applicant's invention.

Thus, for these reasons, as provided above, Applicant respectfully submits that **Claims 21 and 22** are patentable over the cited reference.

O. A. No. 15 - 19. The rejection of **Claim 23** under 35 USC § 103(a) as being unpatentable over MORI in view of MOUISSIE (U.S. Patent No. 4,845,596) is respectfully traversed and it is respectfully submitted that Examiner did not establish a *prima facie* case of obviousness.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under **35 U.S.C. 103**, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03. Moreover, "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." MPEP 608.01(i).

Claim 23 is now a dependent claim, depending from Claim 21.

It was shown above that Mori cannot provide a *prima facie* case of anticipation or thus obviousness, and therefore Claim 21 is now in condition for allowance, and as Claim 23 depends from Claim 21, it too is allowable.

As Mori cannot be used as a primary reference and as neither Mori nor Mouisse teach the use of LED, even in combination they do not teach all of the limitations of Applicant's invention and cannot be used together to reject Applicant's invention.

Moreover, there would be no reason to combine More and Mouisse as Mouisse does not teach “wherein on said at least one visually exposed surface a plurality of predetermined patterns for receiving light comprise informational messages” as claimed by Applicant in Claim 23. Mouisse simply teaches that his illumination device can be used not to in themselves create messages but simply as background illumination of flat information display units such as liquid crystal display panels, text panels, instrument panels, etc.

It follows then that Mori in view of Mouisse does not either expressly or inherently describe Applicant’s invention and thus, for these reasons, as for the reasons provided above, Applicant respectfully submits that **Claim 23** is patentable over the cited references.

ALLOWABLE SUBJECT MATTER

O. A. No. 20 - 21. Claim 24 has been amended to overcome the rejections under 35 U.S. C. 112, 2nd paragraph as set forth in the Office Action and to include all the limitations of base Claim 21.

CONCLUSION

The Prior art made of record and not relied upon was considered.

Applicant believes that all of the claims of the Application are now in condition for allowance. Accordingly, favorable consideration of the present application is respectfully requested so that it may timely pass to issue.

Respectfully submitted,

For Walter E. Pipo, Applicant

/Patricia M. Costanzo/ Electronic Signature
Patricia M. Costanzo
Attorney for Applicant
Reg. No. 48,809

June 5, 2006

P.O. Box 101
2960 Bowen Road
Elma, NY 14059
Telephone: 716-652-2380
Facsimile: 716-652-8868
law@patcostanzo.com